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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,883	11/04/2003	David J. Houston	28647.00003	2882

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/605,883

Applicant(s)

HOUSTON ET AL.

Examiner

Mike Chambers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

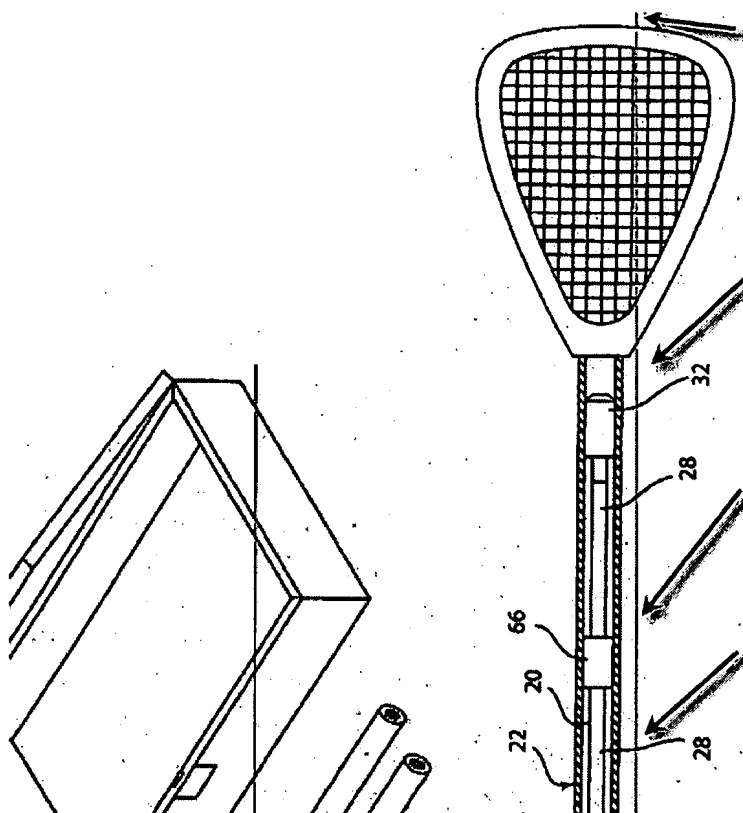
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION***Drawings***

The drawings that were received on 10/5/06 are acceptable for examination purposes only. The fax drawings have an additional line inserted in 6 of the 10 drawings. An example is shown below. The current drawings were filed 10/05/06, the drawings used for the PGPUB publication were filed 11/04/03. As noted in the prior office action, the applicant's fax machine places a line through all the drawings, as noted below and in the prior office action. Since the last drawings filed in the application are used for publication if the application is allowed, the current drawings are unacceptable.



Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 3, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tellechea (5204483). Tellechea discloses a rod assembly including a plurality of individual end threaded connecting rod members, said rod assembly configured to be received within the hollow handle; a first bumper element and a second bumper element connected to said rod assembly on opposing ends of said rod assembly; and wherein at least one of said plurality of individual end threaded rod members provides weight at a selected location along with sport stick. (fig 1-5). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 2 : Tellechea discloses at least one threaded connector (fig 1,5).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference. The mere placement of the device in a sport handle is considered an intended use for the device, which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim limitations. *See In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claim 6: Tellechea discloses a threaded insert (fig 1).

As to claim 7: Tellechea discloses a mid bumper positioned by a friction fit (fig 1, item 52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tellechea as applied to claim 1 above, and further in view of Enos et al (6949037). Enos discloses the use of a pull cord to extract the device (3:25-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the pull cord of Enos with the apparatus in order to more easily remove the device.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (20040248676) in view of Winslow (5328431). Taylor et al discloses the elements of claim 1, however it fails to clearly disclose the use of a plurality of threaded members. Winslow discloses the use of a plurality of threaded members (fig 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the threaded attachment means of Winslow with the apparatus of Taylor et al in order to better secure the weights in the device and/or to more easily customize the device to obtain the desired weight.

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As to claim 2 : Winslow discloses at least one threaded connector (fig 1-3).

As to claim 3: See claim 1 rejection. The intended use defined in the claim breathes no life and meaning structurally different than that of the applied reference. The mere placement of the device in a sport handle is considered an intended use for the device which is not considered a limitation in apparatus claims. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to claims 4 and 5 : Taylor et al discloses an end cap (fig 2).

As to claim 6 : Winslow discloses a threaded insert (fig1- 4).

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (20040248676) in view of Winslow (5328431) as applied to claim 1 above, and further in view of Enos et al (6949037). Enos discloses the use of a pull cord to extract the device (3:25-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the pull cord of Enos with the apparatus in order to more easily remove the device.

Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6949037*5204483*5328431*

July 2, 2007

Michael Chambers
Examiner
Art Unit 3711



EUGENE KIM
SUPERVISORY PATENT EXAMINER